



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shinya TANIGUCHI et al.

Group Art Unit: 2617

Application No.: 10/057,945

Examiner: N. MEHRPOUR

Filed: January 29, 2002

Docket No.: 111828

For: DATA OUTPUT SYSTEM, OUTPUT CONTROL TERMINAL, PROGRAM TO BE APPLIED TO OUTPUT CONTROL TERMINAL, AND DATA OUTPUT METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is filed herewith. Applicants respectfully request review of the rejection mailed July 19, 2007 in the above-identified application.

This review is requested because the §103(a) rejection of claims 1-7, 9 and 11-19 over U.S. Patent No. 6,493,757 (Sakai) and the §103(a) rejection of claims 10 over Sakai in view of U.S. Patent Application Publication No. 2004/0185877 (Asthana) are clearly in error.

I. The Review Panel should reverse the Examiner's rejection of claim 10 over Sakai in view of Asthana because Asthana is not prior art

Asthana has a PCT filing date of June 18, 2002. However, the present application claims priority to JP 2001-034354 (JP '354), filed in the Japanese Patent Office on February 9, 2001. Therefore, as the effective filing date of the present application antedates the PCT filing date of Asthana, Asthana is not prior art. Applicants note that a certified translation of JP '354 was filed in the U.S. Patent Office on February 17, 2005. Thus, for at least this reason, the Review Panel should reverse the Examiner's rejection of claim 10.

II. The Review Panel should reverse the Examiner's rejection of claims 1-7, 9 and 11-19 over Sakai because Sakai fails to teach or suggest generating mobile terminal position information

The Office Action acknowledges that Sakai is not directed to a mobile system.

However, the Office Action alleges that independent claims 1, 2, 13 and 14 are obvious over Sakai because the Office Action takes "official notice" that using a mobile terminal is "well known" in the art and asserts that one of ordinary skill in the art would have been motivated to modify Sakai to provide "a wireless system that enable [sic] the user to be mobile, and move around while using the system." However, this Office Action analysis is flawed, for at least the reasons discussed below.

A. The rejection based on obviousness fails to meet the required burden of proof because the Office Action has failed to provide any rational underpinning to support its legal conclusion of obviousness

Under the USPTO's October 10 examination guidelines ("Guidelines"), an Office Action must provide an explanation "clearly setting forth findings of fact and the rationale(s) to support a rejection" under 35 U.S.C. §103. The "key" to supporting a rejection is the *clear articulation* of the reasons why the invention would have been obvious. These reasons must have *rational underpinnings* and may not be mere *conclusory statements*.

The Office Action asserts that it would have been obvious to modify Sakai to include a mobile terminal to enable a user to be mobile. The Office Action's assertion that one would have modified the claimed invention to include a particular feature because one would have wanted use the particular feature is not based on any rational underpinning, and is simply a conclusory statement. In particular, Sakai is directed to a stationary system, such as a LAN within an office building. See Abstract. Sakai does not address a mobile terminal system, which requires special processing between a mobile terminal and a base station.

The Office Action fails to articulate why one of ordinary skill would have had any reason to modify Sakai's stationary system with the burden of performing processing between

a mobile terminal and a base station, which are not needed for Sakai's stationary system.

In view of the above, the gap between Sakai's stationary system and the claimed invention is "so great as to render the [claim] nonobvious to one reasonably skilled in the art." *See Guidelines.* One of ordinary skill in the art would have realized that Sakai and the claimed invention require different structures and/or perform different processes. Thus, one of ordinary skill would not have had any reason to modify Sakai in the manner asserted.

Even if the Office Action's assertion was based on a rational underpinning, Applicants respectfully disagree with the Office Action's proposed motivation to combine the references. The Office Action assumes that it is inherently desirable for users to "move around while using the system." However, the Sakai disclosure appears to be directed to a business office environment, and in such an environment it seems more likely that it is desirable for users to stay at their work stations, rather than moving around while "using the system." One can easily envision the problems with office workers wandering around the halls while attempting to accomplish their computer work, rather than sitting in their assigned work space to do so.

This argument was also presented in the April 24, 2007 Amendment (the "Amendment"). The Office Action failed to rebut this argument and simply restated the motivation to modify Sakai to enable the user to be mobile.

B. The Review Panel should reverse the Office Action's rejection because Sakai discloses using positions of output devices and not generating positions of a terminal, mobile or otherwise

Even if the Office Action's proposed modification of Sakai were made, Sakai does not render obvious the subject matter recited in the independent claims. Specifically, in Sakai, it is the position of the output devices, such as scanners that is used. This clearly contrasts the claimed invention, which requires that the position of a mobile terminal is generated. The Office Action does not correspond Sakai's output devices with the mobile terminal recited in the claims. Thus, even if modified, Sakai does not teach or suggest the features of the

independent claims.

This argument was presented in the Amendment. The Office Action attempted to rebut this argument by mischaracterizing it and providing an unclear response to Applicants arguments. Specifically, the Office Action responds to the Amendment by asserting that because a mobile phone shows latitude and longitude, "the applicant's [sic] argument is not valid." However, Applicants did not argue about mobility with respect to this issue. Instead, Applicants argued that the position of Sakai's output devices does not disclose or suggest the position of a mobile terminal. Applicants submit that The Office Action's response is irrelevant in the context of the arguments presented above.

C. The Review Panel should reverse the Office Action's rejection because Sakai does not disclose the claimed base station

Claim 1 recites, in part, "generating mobile terminal position information . . . *on the basis of a communication state between the mobile terminal and a base station.*"

Sakai does not disclose a "base station." It is clear that Sakai does not rely on a communication state between a base station and a terminal, mobile or otherwise, for generating terminal position information, such as is recited in each independent claim.

This argument was also presented in the Amendment. The Office Action attempted to rebut this argument by merely asserting the mobile phones communicate with base stations. Such an Office Action assertion fails to respond to Applicants' argument.

Again, Applicants do not claim a mobile phone and instead claim a "mobile terminal." Moreover, the mere fact that a mobile phone may or may not communicate with a base station does not teach or suggest the exact nature of the communication state between a base station and a mobile terminal in the context of the claimed invention.

D. Sakai does not teach or suggest features of the dependent claims

Claim 4, for example, recites transmitting a data output request "when the mobile terminal position is within a predetermined range" and "when a predetermined period of time

has passed." The Office Action relies on certain passages of Sakai as disclosing this feature, but the cited passages clearly have nothing to do with the above-described features. The Office Action fails to identify exactly where these recited features are found in Sakai.

Applicants submitted this argument in the Amendment and requested that if the Examiner relied on Official Notice, that a reference be provided. The Office Action failed to address this argument and also failed to provide any reference or any evidence supporting its taking of Official Notice, as required by MPEP §2144.03.

III. Conclusion

In view of the foregoing, Applicants maintain that all of the pending claims are patentable over the applied prior art, and request the Review Panel to reverse the rejections and allow the application.

Should the Review Panel believe that anything further is desirable to place the application in even better condition for allowance, it is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Notice of Appeal

Date: October 19, 2007

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